

Attorney Docket No.: P6755 (218728-000191)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	DUFOURG)
)
Serial No.	10/606,040)
)
Filed:	June 25, 2003)
)
For:	LATTICE WORK TRUNKING)
)
Examiner:	Chan, Ko Hung)
)
Group Art Unit:	3632)

REPLY BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I. STATUS OF CLAIMS

Claims 1-6 stand rejected and appealed. The claims are set forth in the CLAIMS APPENDIX hereto.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 1-3 are “unpatentable” over Simon (U.S. Patent No. 5,531,410) in view of Hatch (U.S. Patent No. 1,559,695) under 35 U.S.C. §103(a).
2. Whether claims 4-6 are “unpatentable” over Simon in view of Hatch and further in view of Yake (U.S. Patent No. 4,046,261) under 35 U.S.C. §103(a).

III. ARGUMENT

It is respectfully submitted that in rejecting the claims of the present application as being obvious in view of the prior art of record, the Examiner has overlooked the differences set forth in the prior art and resorted to hindsight. When the teaching of the prior art is reviewed in its proper context and consideration is given to the structures set forth in the prior art, the claimed subject matter of the present invention is not obvious over the prior art and should be allowed.

In order to make a proper obviousness analysis, the Federal Circuit has stated that one must reflect upon

the thinking of one of ordinary skill in the [art at the time of the invention], guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of hindsight syndrome wherein that which only the inventor taught is used against its teacher.'

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. . . .

We have noted that evidence of a suggestion, teaching of motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art or, in some cases, from the nature of the problem to be solved. The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular.

In re Dembiczak 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999) (emphasis added). In making the present rejection, the Examiner has relied upon the Simon and Hatch patents, and on the knowledge of one of ordinary skill in the art, but has misconstrued the teaching of the prior art and relied on hindsight in attempting to combine references to obtain the claimed subject matter.

While the Examiner admits that Simon does not teach or suggest, among other things, the bends of the lengthwise wires so that the wires lie at substantially the same level, the Examiner, in order to get around the lack of teaching in the prior art has stated that the motivation to combine the references is found in the references themselves and is in the knowledge generally available to one of ordinary skill in the art. In making this statement, it is respectfully submitted that the Examiner has misconstrued the teaching of Hatch and relied on Appellant's own invention to state that the invention was obvious.

The Examiner has stated that "Simon recognizes that protuberances or protrusions particularly in the upper ends of the transverse or crosswire wires presents the greatest damage to cables. . . . It is well recognized by Simon and in the art as discussed in appellant's background of the invention that the main concerns associated with cableway composed of welded trellis work and protuberances and protrusions associated with transverse or crosswire wires overlapping the lengthwise wires in the trelliswork." However, it is respectfully submitted that in making this statement, the Examiner has misinterpreted the teaching of Simon and the comment made in Appellant's application.

Contrary to the Examiner's unsupported statement that eliminating protuberances and bumps in such supports composed of trellis works are conventional and well known, it is respectfully submitted that none of the prior art dealing with cable ways or latticework trunking addresses this issue. First, in the Background of the Invention, Appellant refers to the Simon patent and stated that "[k]nown latticework trunking of this type does, however, have the disadvantage that the pipes or lines contained in the trunking experience deformation where they cross the crosswise wires, under the effect of their self-weight and/or under the effect of the

pressure exerted by clamps that secure the said pipes or lines to the latticework trunking.” This is a problem that Appellant recognized with the prior art designs such as Simon. Nowhere does Appellant say that protuberances and protrusions associated with transverse or crosswire wires overlapping the lengthwise wires in the trelliswork are the main concerns. Furthermore, even if one were to accept that statement as true, the fact that there is no prior art of record that teaches the claimed subject matter (i.e., meaning that there is no record that one of ordinary skill in the art had come up with Appellant’s solution) implies that the claimed subject matter is, in fact, not obvious.

As for Simon, rather than recognizing problems with protuberances and nodes as the Examiner has stated, Simon is directed to a cable way that includes transverse wires that are folded over at their ends to limit the damage to cables when they are inserted into the cable way. In so doing, as clearly shown in Figure 2, Simon actually introduces, rather than eliminates, protuberances and nodes by bending or folding the ends of the transverse wires. These protuberances or nodes are in addition to the protuberances from the overlapping wires on the bottom of the cable way. Accordingly, it is respectfully submitted that, in addition to not teaching or suggesting the claimed subject matter of Appellant’s invention, Simon actually teaches away from Appellant’s invention by introducing additional protuberances. Additionally, it is submitted that one of ordinary skill in the art would not have considered placing bends in the longitudinal wires at the time of the present invention because, when the latticework trunking is placed on the ground or other flat surface, it decreases the contact area with the surface in which the latticework trunking rests.

Furthermore, it is respectfully submitted that one of ordinary skill in the art would not look to the teaching of Hatch to modify Simon to get the claimed subject matter. Hatch is directed to a portable bottle carrier that is designed to be picked up by a consumer to transport bottles of liquid (e.g., milk). In view of the expected movement of the carrier, its bottom is designed to provide a stable base for the bottles to prevent tipping of the bottles during use. It is not directed to or teach a latticework trunking to permit cables to be lain across. The present invention relates to carrying flexible cable and not rigid glass bottles. The respective problems are not related. The wires in Hatch also are bent to extend vertically at its end. Accordingly, Hatch teaches against the use of cables or lines as they could not be arranged to extend along its wires. Thus, one of ordinary skill in the art would not be motivated by the teaching of a portable bottle carrier that includes substantially U-shaped wires and is designed to prevent tipping of rigid bottles during use when looking to design a latticework trunking for, among other things flexible cables. For all of the reasons set forth herein and in prior arguments, it is respectfully submitted that there is no teaching of the claimed subject matter, and no motivation for one of ordinary skill in the art to combine the teaching in the references with his or her own knowledge to obtain the claimed invention. Appellant's invention is therefore a novel combination of elements that is not shown or taught by the prior art references of record, individually or together. As such novel combinations are, of course, recognized as patentable, it is submitted that Claims 1-3 are patentably distinct over the prior art of record and should be allowed.

With respect to the rejection of Claims 4 and 5-6, Appellant reiterates that there would be no motivation to look to the teaching of a dishwasher rack (as taught by Yake) when looking to design a latticework trunking as claimed. In order to get around this lack of teaching, the

Examiner has stated that the claimed invention is obvious because patents directed to portable bottle carriers and dishwasher racks show particular elements (even though they are in a completely different setting). In doing so, the Examiner has glossed over and eviscerated the test for obviousness. Using this reasoning, any invention would be obvious if the individual elements were known in the prior art, regardless of whether there is any teaching or motivation to combine the references. Accordingly, unless the invention incorporates a unique element, it would not be patentably. As set forth by various courts, this is simply not the test. See e.g., *Al-Site Corp. v. VSI Int'l, Inc.*, 50 U.S.P.Q.2d 1161, 1171 (Fed. Cir. 1999) (citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed.Cir.1983)) (To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher); *Winner Int'l Royalty Corp. v. Wang*, 48 U.S.P.Q.2d 1139, 1144 (D.C. D.C. 1998) (“The standard of obviousness is not whether in hindsight, it seems elementary that someone would have combined these certain elements in the prior art to form the invention in question. *See e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551, [220 USPQ 303, 313] (Fed. Cir. 1983). “Hindsight is almost always perfect. It is insufficient to prove that at the time of the claimed invention, the separate elements of the device were present in the known art. Rather, there must have been some explicit teaching or suggestion in the art to motivate one of even ordinary skill to combine such elements so as to create the same invention”).

In particularly, it is respectfully submitted that the collective teachings of these references would not suggest the claimed subject matter as set forth by the Examiner. In addition to the fact

that Hatch and Yake are directed to unrelated or non-analogous subject matters (namely a portable bottle carrier and a dishwasher rack), one of ordinary skill in the art would not be motivated to combine the references. Yake is directed to a dishwasher rack that has wires that include two lower portions that serve as a base for the rack. Wires extend transversely across these lower portions and, as clearly shown in Fig. 3, the wires 4 and 9 are not in the same plane as the members 12-20. As set forth above, Hatch is directed to a portable bottle carrier and Simon discloses a cable way having a plurality of protuberances (and increasing the amount thereof). It is respectfully submitted that one of ordinary skill in the art would not have any motivation to combine elements from completely unrelated applications with different teachings to obtain the claimed subject matter without the benefit of using hindsight in view of the teaching of Appellant's invention.

IV. CONCLUSION

For the above reasons, Appellant respectfully submits that the Examiner erred in rejecting Claims 1 to 6 under 35 U.S.C. §103 as *prima facie* obvious by using improper hindsight and by misinterpreting the teachings of the prior art. Accordingly, Appellant respectfully submits that the Examiner's rejection of Claims 1 to 6 is in error; that the Examiner's rejection of these claims be reversed; and that their allowance should be accorded.

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Respectfully submitted,

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V. CLAIMS APPENDIX

1. (Previously presented) Cable conduit running longitudinally in a first direction and comprising at least one substantially U-shaped section that has a bottom and two lateral flanges, said substantially U-shaped section extending over a certain length parallel to said first direction between two open ends, and defining an open and unobstructed upper area, and over a certain width at right angle to the first direction, said length being larger than said width, said cable conduit delimiting an interior volume designed to accommodate pipes or lines running longitudinally in the first direction, said cable conduit comprising rigid lengthwise wires running substantially parallel to the first direction and rigid crosswise wires running substantially at right angles to the first direction, the crosswise wires being fixed to the lengthwise wires toward the interior volume of the cable conduit, and each crosswise wire comprising a base portion belonging to the bottom of the cable conduit and two lateral branches belonging respectively to each lateral flange of the cable conduit, wherein at least the lengthwise wires belonging to the bottom of the cable conduit each comprise a succession of longitudinal portions connected by bends protruding away from the interior volume of the cable conduit, the bends of the lengthwise wires being designed to accommodate the base portions of the crosswise wires and being sized so that said base portions of the crosswise wires and the longitudinal portions of the lengthwise wires lie at substantially the same level.

2. (Previously presented) Cable conduit according to Claim 1, in which the longitudinal portions of the lengthwise wires are straight and parallel to the first direction.

3. (Previously presented) Cable conduit according to Claim 1, in which the base

portions of the crosswise wires and the longitudinal portions of the lengthwise wires are arranged in substantially the same plane.

4. (Previously presented) Cable conduit according to Claim 1, in which the bends of the lengthwise wires each have a width, measured in the first direction, that substantially corresponds to the thickness of a crosswire wire.

5. (Previously presented) Cable conduit according to Claim 1, in which the bends of the lengthwise wires each have a width, measured in the first direction, that is greater than twice the thickness of a crosswise wire.

6. (Previously presented) Cable conduit according to Claim 5, in which the bends in the lengthwise wires each have a flat bottom.